

REMARKS

Claims 1 to 17 are presently pending in the subject patent application.

By virtue of the current amendment, the Applicant has cancelled dependent Claims 7, 11 and 16, and independent Claim 17, and has added new dependent Claims 18 to 26.

The Applicant has also amended independent Claims 1, 4, 8 and 12 to state that the items of auxiliary content are selected in accordance with a correlation between the broadcast spaces, and a time instant of issuance of the request for auxiliary content and a web site accessed by the client terminal.

1. CLAIMS 4 to 17: NOVELTY REJECTION

At paragraph 3 of the Office Action, the Examiner rejected Claims 4 to 17 under 35 USC 102(b) as being anticipated by Rakavy (US 5,913,040).

As the Applicant will demonstrate, the invention of independent Claims 4, 8 and 12 is not anticipated by Rakavy.

Rakavy (US 5,913,040)

Rakavy describes a method and computer network for downloading individualized advertisements from an advertising system server to a local computer. The local computer includes a User Interface Setup Process, a Scheduler, an Advertisements Display Manager, and a User Preferences and Advertisements Database. The User Interface Setup Process allows the user to configure the behavior of their computer. The Scheduler schedules the display of time dependent advertisements. The Advertisements Display Manager selects and displays advertisements from the User Preferences and

Advertisements Database, and is activated either by the Schedule or when the user has not entered input for a predetermined time (col. 7, lines 32 to 53; col. 10, lines 43 to 48).

The User Preferences and Advertisements Database stores user preference information, computer configuration information, and advertisements. The user preference information includes the time periods during which advertisements may be downloaded to the local computer (col. 8, line 62 to col. 9, line 49).

When the local computer connects to an advertising system server, the local computer uploads the user's preference and configuration information to the advertising system server. Thereafter, the local computer requests the next advertisement from the advertising system server. The advertising system server uses the uploaded preference and configuration information to select an advertisement to be downloaded, and then transmits to the local computer a resource list that identifies the resources required to display the advertisement. The local computer queries the User Preferences and Advertisements Database with the resource list, and downloads any resources required. The local computer then adds the advertisement to the User Preferences and Advertisements Database once the required resources have been downloaded (col. 5, lines 32 to 47; col. 12, lines 19 to 40).

Therefore, Rakavy describes receiving at advertising system server, over a network, a request from a local computer for an item of auxiliary content. However, the advertising system server does not select the auxiliary content in accordance with a correlation between a broadcast space and a time instant of issuance of a request from a client terminal for the auxiliary content, as required by independent Claim 4 of the subject patent

application. Instead, the advertising system server selects an advertisement based on the user's preference and configuration information (col. 12, lines 19 to 26), without regard to the time instant that the local computer issues the advertising content request to the advertising system server.

Although Rakavy discloses that some advertisements may be time dependent, the time dependency is only used by the Scheduler on the local computer to schedule the display (not the selection) of the advertisements (col. 7, lines 51 to 53). Further, the Scheduler does not schedule the display of the advertisements based on the time instant of issuance of a request from the local computer for the auxiliary content. Moreover, the local computer does not download the advertisement from the advertising system server based on any particular time information, but instead downloads the advertisement in background, during periods of low network utilization (col. 13, lines 5 to 13).

Further, neither the advertising system server nor the local computer selects the auxiliary content based on a web site accessed by the client terminal, as required by independent Claim 4 of the subject patent application.

Since Rakavy does not teach selecting auxiliary content in accordance with a correlation between a broadcast space and a time instant of issuance of a request from a client terminal for the auxiliary content, and does not teach selecting auxiliary content in accordance with a web site accessed by the client terminal, independent Claim 4 is not anticipated by Rakavy.

Independent Claims 8 and 12 include similar limitations to independent Claim 4. Therefore, Claims 4 to 17 are not anticipated by Rakavy.

Accordingly, the Applicant respectfully requests that the Examiner withdraw the 35 USC 102(b) rejection to Claims 4 to 17.

2. CLAIMS 1 to 3: OBVIOUSNESS REJECTION

At paragraph 5 of the Office Action, the Examiner rejected Claims 1 to 3 under 35 USC 103(a) for being obvious over Rakavy in view of Judson (US 5,737,619).

As the Applicant will explain, the prior art cited by the Examiner fails to teach all the limitations of independent Claim 1. Further, the Examiner's justification for combining the identified references is inconsistent with the established jurisprudence for the determination of obviousness. Therefore, the Examiner's analysis and the cited art are insufficient to sustain a *prima facie* obviousness rejection of independent Claim 1.

Prior Art Fails To Teach All Claim Limitations

As discussed above, the advertising system server of Rakavy does not select one of the items of auxiliary content in accordance with a correlation between a broadcast space and a time instant of issuance of a request from a client terminal for the auxiliary content and a web site accessed by the client terminal, as required by independent Claim 1 of the subject patent application. Instead, the advertising system server selects an advertisement based on the user's preference and configuration information, without regard to the time instant that the local computer issues the advertising content request to the advertising system server, or the web site accessed by the local computer.

Although Rakavy discloses that some advertisements may be time dependent, the time dependency is only used by the Scheduler on the local

computer to schedule the display of the advertisements. Further, the Scheduler does not schedule the display of the advertisements based on the time instant of issuance of a request from the local computer for the auxiliary content.

Moreover, neither the advertising system server nor the local computer selects the auxiliary content based on a web site accessed by the client terminal, as required by independent Claim 4 of the subject patent application.

These deficiencies in the teachings of Rakavy are not ameliorated by Judson.

Judson (US 5,737,619)

Judson describes a method of downloading web content over an idle network connection. The method begins by displaying a web page on a client. The web page has one or more HTML comment or image tags that include links to a document located on a remote server. Since the document link is embedded in an object or image tag, the link is not displayed by the browser. When the user selects the link, the client's browser requests the document from the remote server (col. 2, lines 34 to 54; col. 6, lines 2 to 27).

Judson does not select an item of auxiliary content in accordance with a correlation between a broadcast space and a time instant of issuance of a request from a client terminal for the auxiliary content, as required by independent Claim 1 of the subject patent application. The Applicant notes that the Examiner asserted that this feature was disclosed by Judson, at col. 2, lines 40 to 53 thereof. However, the passage cited by the Examiner only

states that while the client is waiting for the document to download, the client's web browser displays an information message that may be related to the document being downloaded. Although Judson discloses that the document begins downloading after the time instant that the user selects the document link, Judson does not teach or suggest that the document that is selected for download is based on a broadcast space for documents and the time instant that the user selects the document link.

Since the prior art cited by the Examiner therefore does not teach all of the limitations of independent Claim 1, the invention of Claim 1 cannot be considered to be obvious in view of the cited references.

Motivation To Combine References Inconsistent With Claimed Invention

In KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (April 30, 2007), hereinafter "KSR", the United States Supreme Court stated that, in order to sustain a *prima facie* obviousness rejection, the Examiner has the legal burden of demonstrating obviousness using articulated reasoning and a rational underpinning. The Applicant also reminds the Examiner that, as part of that burden, KSR requires the Examiner to demonstrate that the reason for combining the references was known in the field of the art, and addressed by the patent or patent application. The Applicant submits that the Examiner failed to meet this burden.

As recited in independent Claim 1, the content selection means selects one of the items of auxiliary content in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from a client terminal for the auxiliary content and a web site accessed by the client terminal. By selecting the item of auxiliary content in this fashion, the content delivery server is able to closely tailor the auxiliary content to the

client's immediate interests and the time of day. Therefore, the invention of the subject patent application addressed the problem of accurately tailoring auxiliary content to the user.

However, at page 8 of the Office Action, the Examiner stated that the claimed invention was obvious over Rakavy in view of Judson, on the basis that the person of ordinary skill would be motivated by the desire to serve an advertisement in an instant. Since the Examiner's reason for combining the cited art references, namely increased download speed, is unrelated to the purpose of the invention recited in Claim 1, the Applicant submits that the Examiner's discussion of motivation is inconsistent with the legal burden, placed on the Examiner, of demonstrating obviousness using articulated reasoning and a rational underpinning.

In view of the foregoing deficiencies, the Applicant submits that the art cited by the Examiner is insufficient to sustain a *prima facie* case of obviousness with regards to the invention recited in the pending claims. Therefore, the Applicant respectfully requests that the Examiner withdraw the 35 USC 102(b) rejection of Claims 1 to 3 of the subject patent application.

Applicant respectfully submits that all of the Examiner's substantive bases for rejection of the claims should be deemed overcome. Reconsideration, and allowance of claims 1 - 6, 8 - 10, 12 - 15 and 18 - 26 are respectfully solicited.

In view of the foregoing amendments, Applicant respectfully submits that the application, as a whole, is now in *prima facie* condition for allowance.

Application No. 10/523,237
Amendment dated November 14, 2008
Response to Office Action of May 14, 2008

Therefore, reconsideration and allowance of the application are respectfully solicited.

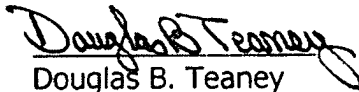
As a result of the foregoing amendments, a net total of two (2) claims have been added. Applicant hereby expressly authorizes that the small entity extra claim charge of \$52.00 for two (2) claims beyond 20 be charged to Applicant's attorneys' deposit account no. 502428.

Should anything further be required, a telephone call to the undersigned, at 312-456-8400, is respectfully solicited.

Respectfully submitted,

GREENBERG TRAURIG, P.C.

Dated: November 14, 2008


Douglas B. Teaney
One of Attorneys for Applicant